

REMARKS

Prior to this communication, claims 1-20 are pending in the application. In the pending action, the Office

- objected to claim 12, 15, and 16 as being dependent upon a rejected base claim;
- rejected claims 5, 6, and 17 under 35 U.S.C. § 112, 2nd paragraph;
- rejected claims 1-3, 9, and 10 under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent No. 5,514,943 (Shapess);
- rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Shapess in view of U. S. Patent No. 4,453,118 (Phillips); and
- rejected claims 8, 11, 13, 14, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Shapess in view of U. S. Patent No. 5,883,488 (Woodward).

In this Amendment Applicants

- cancelled claims 4-6, 10, 11, and 19;
- amended claims 1, 8, 9, 12, 13, 15, and 17; and
- added claims 21-27.

Applicants request reexamination and reconsideration in view of the remarks contained herein.

Claims 5, 6, and 17 stand rejected under 35 U.S.C. § 112, 2nd paragraph. Applicants amended the claims to remove the limitation “a combination thereof” without prejudice. Applicants disagree with the rejection and reserve the right to reintroduce the limitation in the future. Regardless, Applicants request the Office to remove the rejection.

The Office indicated claim 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and amended to overcome the rejection under 35 U.S.C. § 112, 2nd paragraph. Applicants have amended claim 1

to read as if claim 6 was rewritten in independent form including all of the limitations of the base claim and any intervening claims, with the exception of the amendment to overcome the rejection under 35 U.S.C. § 112, 2nd paragraph. Accordingly, claim 1 is now allowable.

Claims 2, 3, 7, 8, and 21-27 depend, either directly or indirectly, from claim 1, and consequently, include patentable subject matter for the reasons set forth above with respect to claim 1. Therefore, dependent claims 2, 3, 7, 8, and 21-27 are allowable. Further, Applicants assert claims 2, 3, 7, 8, and 21-27 specify additional limitations that, in combination with claim 1, are believed to be separately patentable.

Applicants have amended claim 9 to include, among other things, the limitations of claim 11. Claim 11 stands rejected as being unpatentable over Shapess in view of Woodward. Amended claim 9 recites an electric machine assembly comprising, among other limitations, a controller comprising a current sensor coupled in circuit with a first speed circuit to sense a current of the first speed circuit, the controller being configured to control operation of a switch of the first speed circuit based at least in part on whether an operational power is provided to the first speed circuit or a second speed circuit, the controller controlling the switch to limit current through the switch when the second speed circuit receives the operational power, wherein controlling operation of the switch based at least in part on whether an operational power is provided to the first speed circuit or the second speed circuit is based at least in part on an output of the current sensor. The Office has acknowledged that Shapess does not teach or suggest, among other things, the limitations of claim 11. Therefore, Shapess does not teach or suggest the recited limitations of amended claim 9.

The Office asserts Woodward cures the deficiencies of Shapess with respect to the limitations of claim 11. However, Applicants assert Woodward does not teach or suggest a current sensor coupled in circuit with the first speed circuit to sense a **current of the first speed circuit**. Rather, the current sensor cited by the Office (R1) is connected in circuit with the first speed circuit **and** the second speed circuit to sense a **current of the motor**, which is different than a current of the first speed circuit. Therefore, the cited references, either alone or combined, do not teach or suggest all the limitations of amended claim 9. Accordingly, claim 9 is allowable.

Claims 13 and 14 depend, either directly or indirectly, from claim 9, and consequently, include patentable subject matter for the reasons set forth above with respect to claim 9. Therefore, dependent claims 13 and 14 are allowable. Further, Applicants assert claims 13 and 14 specify additional limitations that, in combination with claim 9, are believed to be separately patentable.

Claim 15 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, which Applicants have done. Accordingly, claim 15 is now allowable.

Claim 16 depends from claim 15, and consequently, includes patentable subject matter for the reasons set forth above with respect to claim 15. Therefore, dependent claim 16 is allowable. Further, Applicants assert claim 16 specifies additional limitations that, in combination with claim 15, are believed to be separately patentable.

Claim 17 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and amended to over come the rejection under 35 U.S.C. § 112, 2nd paragraph, which Applicants have done. Accordingly, claim 17 is now allowable.

Claim 18 stands rejected as being unpatentable over Shapess in view of Woodward. Amended claim 18 recites a method of controlling an electric machine, the method comprising, among other limitations, detecting a **peak current of the first speed circuit** to determine whether the first speed circuit or the second speed circuit is receiving the operational power. The Office would appear to acknowledge that Shapess does not teach or suggest, among other things, the just-recited limitations of claim 18. Therefore, Shapess does not teach or suggest claim 18.

The Office asserts Woodward cures the deficiencies of Shapess with respect to the recited limitations of claim 18. However, Applicants assert Woodward does not teach or suggest detecting a **peak current of the first speed circuit** to determine whether the first speed circuit or the second speed circuit is receiving the operational power. Rather, the current sensor cited by the Office (R1) is connected in circuit with the first speed circuit and the second speed circuit to detect a **current of the motor**, which is different than a peak current of the first speed circuit.

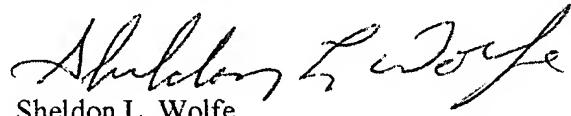
Therefore, the cited references, either alone or combined, do not teach or suggest all the limitations of amended claim 19. Accordingly, claim 19 is allowable.

Claim 20 depends from claim 19, and consequently, includes patentable subject matter for the reasons set forth above with respect to claim 19. Therefore, dependent claim 20 is allowable. Further, Applicants assert claim 20 specifies additional limitations that, in combination with claim 19, are believed to be separately patentable.

CONCLUSION

Entry of the Amendment and allowance of the application are respectfully requested. The undersigned is available for telephone consultation at any time during normal business hours.

Respectfully submitted,



Sheldon L. Wolfe
Reg. No. 43,996

Docket No.: 010121-9929-01

Michael Best & Friedrich LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

T:\clients\010121\9929\A1318968.1